


PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|   |   |  |
|---|---|--|
| Divisional Application of:                          | ) | <u>CERTIFICATE OF EXPRESS MAILING</u>  |
| Hector F. DeLuca                                    | ) | I hereby certify that this correspondence is   |
| Rafal R. Sicinski                                   | ) | being deposited with the United States Postal  |
| Pawel K. Grzywacz                                   | ) | Service with sufficient postage as   |
| Attorney Docket: 1256-00939                         | ) | EXPRESS MAIL in an envelope addressed  |
|   | ) | to: Commissioner for Patents, P.O. Box   |
| <b>Parent Application Data:</b>                     | ) | 1450, Alexandria, VA 22313-1450, on this   |
| Application No.: 10/127,180                         | ) | 22nd day of January, 2004. The Express   |
| Filed: April 22, 2002                               | ) | Mail Label is EV383667380US.   |
| Examiner: Sabiha Naim Qazi                          | ) |  |
| Group Art Unit: 1616                                | ) | <u></u> January 22, 2004 |
| (20S)-1 $\alpha$ -Hydroxy-2 $\alpha$ -Methyl and    | ) | Dorothy A. Hauser Date   |
| 2 $\beta$ -Methyl-19-Nor-Vitamin D <sub>3</sub> and | ) |  |
| Their Uses  | ) |  |

INFORMATION DISCLOSURE STATEMENT

Mail Stop: Divisional Application  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

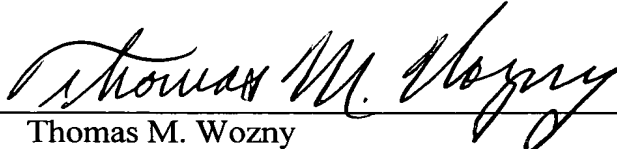
Sir:

The references listed on the enclosed PTO Form 1449 are being submitted in the above-identified patent application in accordance with 37 CFR 1.97(b)(1).

A copy of each of the listed references is enclosed in compliance with the rules.

Respectfully submitted,

ANDRUS, SCEALES, STARKE & SAWALL, LLP

By   
Thomas M. Wozny  
Reg. No. 28,922

Andrus, Sceales, Starke & Sawall, LLP  
100 East Wisconsin Avenue, St. 1100  
Milwaukee, WI 53202  
(414) 271-7590

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO

## INFORMATION DISCLOSURE STATEMENT BY APPLICANT

*(Use as many sheets as necessary)*

**Complete if Known**

Application Number

Filing Date

January 22, 2004

First Named Inventor

Hector F. DeLuca

### Art Unit

Examiner Name \_\_\_\_\_

Attorney Docket Number

1256-00939

Sheet

1

of

2

## U. S. PATENT DOCUMENTS

[illegible]

## FOREIGN PATENT DOCUMENTS

[illegible]

**Examiner  
Signature**

Date  
Considered

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.*

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

|  |            |    |   |                          |                  |
|--|------------|----|---|--------------------------|------------------|
| Substitute for form 1449/PTO<br><br><b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br><br><i>(Use as many sheets as necessary)</i> |            |    |   | <b>Complete if Known</b> |                  |
|  |            |    |   | Application Number       |                  |
|  |            |    |   | Filing Date              | January 22, 2004 |
|  |            |    |   | First Named Inventor     | Hector F. DeLuca |
|  |            |    |   | Art Unit                 |                  |
| Examiner Name  |            |    |   |                          |                  |
| Attorney Docket Number   | 1256-00939 |    |   |                          |                  |
| Sheet  | 2          | of | 2 |                          |                  |

| NON PATENT LITERATURE DOCUMENTS |                       |   |                |
|---------------------------------|-----------------------|---|----------------|
| Examiner Initials*              | Cite No. <sup>1</sup> | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.   | T <sup>2</sup> |
|                                 |                       | SICINSKI ET AL, "New 1Alpha-25-Dihydroxy-19-Norvitamin D3 Compounds of High Biological Activity: Synthesis and Biological Evaluation of 2-Hydroxymethyl, 2-Methyl, and 2-Methylene Analogues," Journal of Medicinal Chemistry, American Chemical Society, 22 October 1998, pp. 4662-4674, Vol. 41, XP002105465. |                |
|                                 |                       | BOUILLON ET AL, "Structure-Function Relationships in the Vitamin D Endocrine System," Endocrine Reviews, April 1995, pp. 200-257, Vol. 16, No. 2, XP002247361.  |                |
|                                 |                       | CASTEDO ET AL, Palladium-Catalyzed Synthesis of Dienynes Related to Vitamin D from Enol Triflates," Tetrahedron Letters, 1986, pp. 1523-1526, Vol. 27, No. 13, XP009013726.   |                |
|                                 |                       |   |                |
|                                 |                       |   |                |
|                                 |                       |   |                |
|                                 |                       |   |                |
|                                 |                       |   |                |
|                                 |                       |   |                |
|                                 |                       |   |                |
|                                 |                       |   |                |
|                                 |                       |   |                |

|                    |  |                 |  |
|--------------------|--|-----------------|--|
| Examiner Signature |  | Date Considered |  |
|--------------------|--|-----------------|--|

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.